



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,422	07/02/2001	Hiroaki Shinohara	50R4615	1895

7590 10/19/2005

John L. Rogitz
Rogitz & Associates
Suite 3120
750 B Street
San Diego, CA 92101

EXAMINER

SHIBRU, HELEN

ART UNIT	PAPER NUMBER
----------	--------------

2616

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,422

Applicant(s)

SHINOHARA, HIROAKI

Examiner

HELEN SHIBRU

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. Figure 1 is objected to under 37 CFR 1.83(a) because unit 30 should be labeled as 'database' as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2616

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Killian (US Pat. No. 6,163,316).

Note to the Applicant: The USPTO considers the Applicant's "at least one of" and "or" languages to be anticipated by any reference containing one of the subsequent corresponding elements.

Regarding claim 1, Killian discloses a system for returning recommendations related to a recorded program, comprising:

a TV (see fig.1 television (40); and

a personal video recorder (PVR) (see fig. 1 recorder (20)) including a processor (see processor (8) in fig. 1) coupled to the TV and receiving media-stored content (see col. 3 lines 6-18), the processor accessing at least one database to return recommendations based at least partially thereon (see col. 7 lines 49-64, col. 8 lines 36-49, and col. 10 lines 61-66) or to record at least one broadcast program based thereon (see col. 8 lines 5-26).

Regarding claim 2, Killian discloses the processor receives a viewer selected portion of the content (see col. 3 lines 12-18 and col. 4 lines 55-67), the processor accessing the database based at least partially on the selected portion (see col. 5 lines 1-10 and col. 6 lines 19-31) or recording a broadcast program based at least partially on the selected portion (see col. 8 lines 5-21).

Regarding claim 3, Killian discloses an input device (see input device (42) in fig. 1) manipulable to establish the selected portion (see col. 4 lines 55-64 and col. 9 lines 36-42).

Regarding claim 4, Killian discloses a DVD player communicating with the TV for playing the media-stored content (see fig. 1 recorder (20), which is also a player, is a video disk recorder, or any other recording device suitable to record video and audio television signals (see col. 3 lines 10-12, and col. 4 lines 20-28). The TV receives signals to be played back from the recorder (see col. 4 lines 20-23 and lines 55-58). Control application programming interfaces (API) controls the operation of the recorder including playing (see col. 7 lines 25-28)).

Regarding claim 5, Killian discloses the database is updatable with information available on a wide area computer network (WAN) (see fig. 1 internet link (14), DB server (46), platform (12), database (48), and col. 3 lines 45-50 and col. 16 lines 31-40).

Regarding claim 6, Killian discloses the processor accesses the WAN to update the database (see fig. 1 processor (8), internet link (14), DB server (46), platform (12), database (48), and col. 4 lines 7-19 and col. 7 lines 8-16).

Regarding claim 7, Killian discloses a method for providing and recommending audio-video programs and/or content based on a viewer selection of a portion of content played on the TV (see col. 3 lines 59-64 and col. 17 lines 29-43), comprising

receiving the content at the TV (see col. 4 lines 35-67, col. 5 lines 56-62, col. 6 lines 10-15 and col. 9 lines 36-42);

receiving at least one viewer selection of at least a selected portion of the content (see col. 16 line 51-col. 17 line 6);

automatically returning at least one viewing recommendation based at least in part on the selected portion (see col. 16 line 51-col. 17 line 6), or automatically recording a broadcast

program based at least in part on the selected portion (see col. 11 line 50-col. 12 line 7, col. 15 lines 29-38 and col. 17 lines 7-29).

Regarding claim 8, Killian discloses adding the viewer selection to at least one viewing history stored in a PVR (see col. 6 lines 19-31 and col. 10 lines 61-66).

Regarding claim 9, Killian discloses receiving the content from a player associated with the TV, the content being media-stored content (see col. 4 lines 20-28).

Regarding claim 10, Killian discloses the player is a DVD player (see col. 3 lines 11-12, col. 4 lines 55-58, the video disc recorder, or other recording device suitable to record video and audio television signals are used as a player as well, and claim 4 rejection).

Regarding claim 11, Killian discloses the recommendation is stored in a database (see col. 3 lines 59-64 and col. 5 lines 1-9), and the method includes updating the database using information on a WAN (see col. 4 lines 7-19 and col. 16 lines 31-37).

Regarding claim 12, Killian discloses system for linking content to viewing recommendations, comprising:

means for receiving the content (see col. 4 lines 35-67, col. 5 lines 56-62, col. 6 lines 10-15 and col. 9 lines 36-42);

means for receiving a viewer selection of at least some of the content (see col. 16 line 51-col. 17 line 6); and

means responsive to the viewer selection for automatically accessing a source of recommended viewing (see col. 16 line 51-col. 17 line 6).

Regarding claim 13, Killian discloses means for storing at least some of the content (see fig. 6 receive figure input (207), input device (42) in fig. 1, col. 5 lines 4-11, and col. 7 lines 49-58).

Regarding claim 14, Killian discloses the content includes alpha numeric characters that are part of a DVD content (see col. 10 lines 18-21 and 40-43, and claim 4 rejection).

Claim 15 is rejected for the same reason as discussed in claim 3 above.

Regarding claim 16, the claim limitation of claim 16 can be found in claim 7 above. Therefore claim 16 is analyzed and rejected for the same reason as discussed in claim 7.

Regarding claim 17, Killian discloses the means for receiving a viewer selection includes a personal video recorder (PVR) (see recorder (20) in figure 1 and col. 3 lines 27-33).

Regarding claim 18, Killian discloses the source of recommended viewing communicates with a WAN (see col. 3 lines 18-33 and bidirectional internet link (14) in fig. 1).

Regarding claim 19, Killian discloses media player means associated with the means for receiving content for playing media-stored content on a storage medium and sending the media-stored content to the means for receiving content (see col. 3 lines 11-12, col. 4 lines 20-28 and lines 55-58, and claim rejection 10).

Regarding claim 20, Killian discloses for recording broadcast content based on a viewer selection of a portion of content, comprising:

means for receiving the content (see col. 4 lines 35-67, col. 5 lines 56-62, col. 6 lines 10-15 and col. 9 lines 36-42);

means for receiving a viewer selection of at least a portion of the content (see col. 16 line 51-col. 17 line 6); and

means responsive to the viewer selection for automatically recording at least one broadcast program (see col. 11 line 50-col. 12 line 7, col. 15 lines 29-38 and col. 17 lines 7-29).

Regarding claim 21, Killian discloses means for storing at least some characters in the selected portion (see col. 10 lines 18-21 and 40-43).

Regarding claim 22, Killian discloses the characters are part of a DVD content (see claim 4 rejection).

Claim 23 is rejected for the same reason as discussed in claim 3 above.

Regarding claim 24, the claim limitation of claim 24 can be found in claim 7 above. Therefore claim 16 is analyzed and rejected for the same reason as discussed in claim 7.

Claim 25 is rejected for the same reason as discussed in claim 17 above.

Claim 26 is rejected for the same reason as discussed in claim 6 above.

Regarding claim 27, Killian discloses media player means associated with the means for receiving content for playing media-stored content on a storage medium (see col. 15 lines 29-38) and sending the media-stored content to the means for receiving content (see col. 4 lines 20-23 and 55-58), the characters being part of the media-stored content (see col. 10 lines 18-21 and 40-43).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shinohara (US 20030002850) itself.

Regarding claim 21, claim 21 requires that storing at least some characters in the selected portion. Shinohara discloses in the specification that using image recognition technology known in the art, the viewer might select a non-alpha numeric portion of the played content (see paragraph 0023). Official Notice is taken that it is well known in the art at the time the invention was made to use image recognition technology. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a non-alpha numeric character in order to select a content.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dunn (US Pat. No. 6, 668, 377) discloses trailers linked to a specific program.

Alexander (US Pat. No. 6,177,931) discloses a system that provided related programs and linked to the Internet and a DVD player and recorder.

Herrington (US Pat. No. 6, 865, 746) discloses a VCR and an EPG that provide a user to search for matching programs.

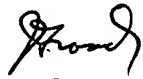
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

Art Unit: 2616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES GROODY can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Helen Shibru
October 13, 2005


James J. Groody
Supervisory Patent Examiner
Art Unit 262 2616